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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,221	07/08/2003	Ken Kutaragi	450128-04021.1	8672
20999	7590	01/27/2005	EXAMINER	
FROMMER LAWRENCE & HAUG			FOSTER, JIMMY G	
745 FIFTH AVENUE- 10TH FL.			ART UNIT	
NEW YORK, NY 10151			PAPER NUMBER	

3728

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,221

Applicant(s)

KUTARAGI ET AL.

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/10/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The previous time period for response which was set in the last Office action is hereby vacated in view of this Office action and time period that is set by this Office action. The requirement to respond to the last Office action is withdrawn.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 18, 22, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over published Japanese Laid-open Publication No. H05-213387 in view of published Japanese Utility Model Publication No. H04-32993. The Japanese document H05-213387, with respect to Figure 4, apparently shows/discloses using a book or notebook for holding different shaped media elements A and B, such as for holding a CD or DVD A (examiner's notation), which is circular in shape, and for holding an optical disc cartridge B (examiner's notation) which is rectangular in shape. Moreover the Japanese document No. H05-213387 discloses holding both of the media elements on the same notebook member 1 (examiner's notation) on one side of the hinge member

3. Notebook member 1 may be considered to define a first member; notebook member 2 (examiner's notation) may be considered to define a second member; and notebook member 3 (examiner's notation), which acts as a hinge between

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members 1 and 2, may be considered to define a connecting member. The region accommodating the circular element A may be considered to define a first accommodating region, and the region accommodating the rectangular element B may be considered to define a second accommodating region.

The media elements A and B are capable of being used in an appropriately configured gaming apparatus and of receiving data therefrom. Moreover, the holders for the circular and rectangular shaped medias are inherently respectively capable of holding a circular recording media of appropriate size having a game software and holding a rectangular recording device of appropriate size which will be mounted in a game system. This capability meets the intended use limitations set forth in the claims.

Although the Japanese document H05-213387 does not appear to disclose the holder for the rectangular media element B as defining a frame portion extending upwardly from the base of the first member 1, the Japanese document No. H04-32993 suggests that the holder for a rectangular media element/recording device, such as a memory card (3), may be formed by four L-shaped protruding portions (2), for retaining the rectangular media at the corners thereof, for the purpose of retaining the rectangular media suspended above the flat surface of the member (1). The holding structure causes storage of the media spaced above the base of the member (1) (see Fig. 2), which will permit easy grasping for removal of the rectangular media. Accordingly, it would have been obvious in view of Japanese document No. H04-32993 to have made the rectangular media holder at B (examiner's notation) of Figure 4 of Japanese document H05-213387 with L-shaped protruding portions which extend from the base of the first member 1, for the purpose of holding a rectangular media/such as a recording device memory card, above the flat surface of the base so as to permit the media to be grasped to be removed.

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With the spaced L-shaped protrusions, portions of parallel side surfaces of the rectangular media/recording device will not be engaged. This will permit the sides to be grasped for removing the media from the holder.

It has been held that mere duplication of the essential working parts of a device to duplicate function of the structure involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Accordingly, to have provided more than one holding portion, each including L-shaped protrusions, for holding plural rectangular recording devices would further have been obvious as constituting a mere duplication of structure and function of what is taught by Japanese document No. H04-32993.

Regarding claim 28, which defines the recording device as being a card-type, including a convex-concave portion in its side surface, the recording device has not been set forth as structure in the claims but as intended use. The term (verb) "accommodating" (claim 27) in the limitation, "a second accommodating region accommodating said card-type recording device" merely requires that the accommodating region provide space for a card-type recording device, and does not structurally define the card-type recording device as being disposed in the accommodating region. Therefore, any limitation with respect to the convex-concave portion in the side of the card-type recording device is also one of intended use. The rectangular accommodating region of Japanese document H05-213387, as modified above in view of Japanese document No. H04-32993, would be inherently capable of holding a card-type recording device of appropriately smaller size therein, including one which includes a convex-concave portion.

If Applicant desires that the recording medium and recording device be treated as structure, Applicant may change the limitation, "a first accommodating region accommodating said disc-type recording medium" to the

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limitation, "a first accommodating region having said disc-type recording medium disposed therein", and may change the limitation, "a second accommodating region accommodating said card-type recording device" to the limitation, ""a second accommodating having a said card-type recording device disposed therein".

3. Claims 19, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over published Japanese Laid-open Publication No. H05-213387 in view of published Japanese Utility Model Publication No. H04-32993 as applied to claim 18, 22 or 27 above, and further in view of Fraser et al (5,788,068). The reference of Fraser at 11 and 11A, suggests that the second cover member (11) of a media case may includes clips/manual holding portions (11A) for holding a manual/booklet in/on the surface of the cover member, for apparently providing written information with the recording medium. Accordingly, it would have further been obvious in view of Fraser et al to have provided the second cover member 2 of the published Japanese document H05-213387 with manual holding portions for providing written information with the recording medium.

4. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over published Japanese Laid-open Publication No. H05-213387 in view of published Japanese Utility Model Publication No. H04-32993 as applied to claim 22 or 27 above, and further in view of U.S. patent No 6,276,524 to Cerda-Vilaplana et al. Although the Japanese document H05-213387 does not appear to disclose the holder for the circular media element A as being formed by an arcuate frame portion raised from the base of the first element 1, the reference of Cerda-Vilaplana et al, at projections 1d and disclosure

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thereof, suggests that the holder for a circular media element, such as a compact disc (CD), may include six spaced, stepped arcuate frame portions (1d) raised from the base (1b) of a case member, apparently for the purpose of supporting the outer edge of the media above the flat surface of the case member. This would inherently hold the underside of the media from coming into contact with the flat surface. Moreover, as apparent from the reference, the frame portions (1d) would function along with a retainer of a cylindrical platform (2) to retain the media in the case but permit easy release of the media when desired.

5. Claims 20, 21, 25, 26, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over published Japanese Laid-open Publication No. H05-213387 in view of published Japanese Utility Model Publication No. H04-32993 as applied to claim 18, 22 or 27 above, **and further in view of** the published Japanese Application No. 08-002572 to Takiguchi et al. The reference of Takiguchi et al suggests that different shaped media devices, such as a flexible disk and a compact disc, may be arranged on a member of a storage case in an orientation wherein their alignment is parallel to the axis of the length of the case member, which apparently provides an efficient arrangement of the media devices in the case. Additionally, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. For these reasons, it would have further been obvious in view of Takiguchi et al to have arranged the accommodating regions A,B (examiner's notation) of Japanese document H05-213387 so that their alignment is parallel to the length of the first member 1.

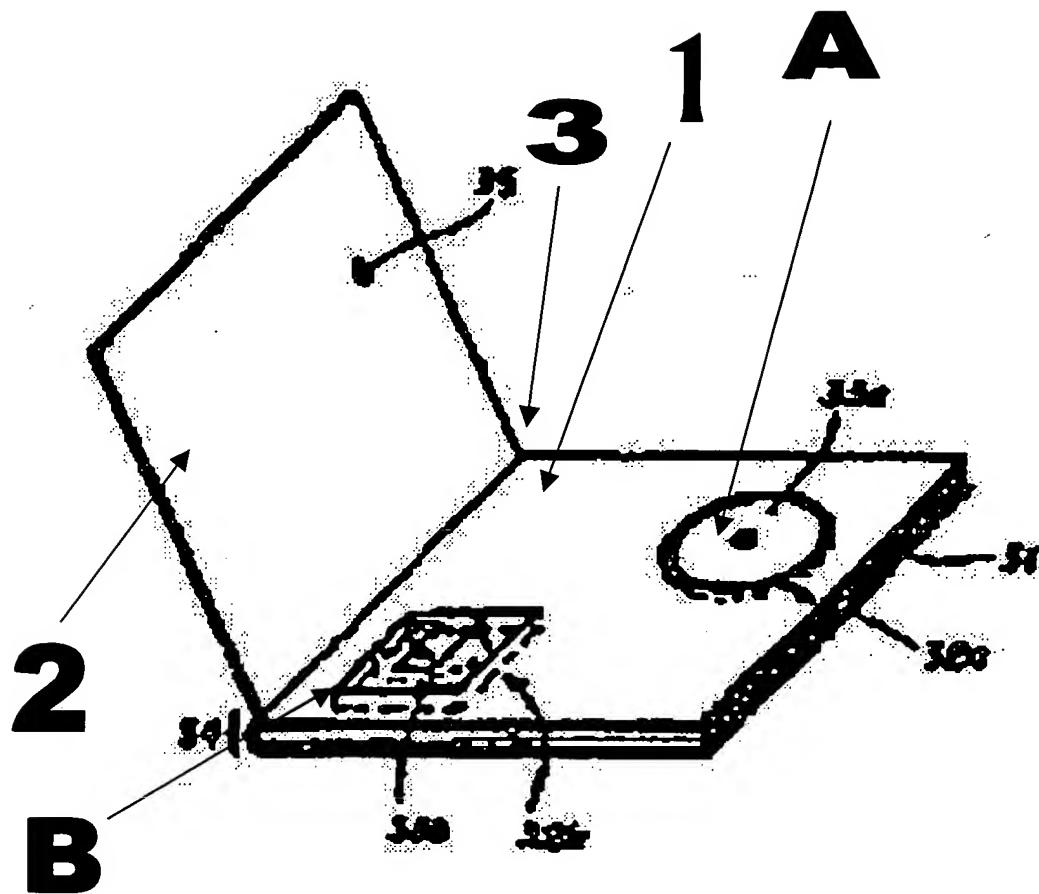
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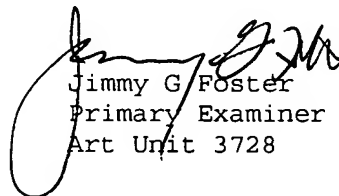


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (571) 272-4554. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
21 January 2005